REMARKS

Claims 1, 2, 4, 5, 8, 10, 12-14, 18-22, 31 and 36 are pending. Claim 31 is amended herein for clarity. No new matter is added in this Response.

1. Previously cancelled claims

The Office Action mailed March 17, 2008 rejected claims 27 and 28 under 35 U.S.C. § 102(b). However, claims 27 and 28 were previously cancelled. Applicants request withdrawal of this rejection.

The Office Action rejected claims 6, 9, 16, 17, 29, 32, 35, and 37 under 35 U.S.C. § 103(a). However, claims 27 and 28 were previously cancelled. Applicants request withdrawal of this rejection.

The Office Action rejected claim 36 as dependent on a cancelled claim. However, claim 36 depends from claim 31, and claim 31 is pending, so the Office Action's assertion of incorrect dependency is incorrect. Applicants request withdrawal of this rejection. The Office Action presents no substantive rejection of this claim, so Applicants request allowance of claim 36.

2. Claims 1, 2, 4, 8, 10, 12-14, 18-22, 31 and 36

The Office Action rejected claims 1, 2, 4, 8, 10, 12-14, 18-22, and 31 under 35 U.S.C. § 103(a) over *Isamu* in view of *White*. However, in order to render a claim obvious, the cited references must suggest each and every limitation of the claim. *See* MPEP § 2143. The

combination of *Isamu* in view of *White* fails to teach all elements of those claims, and thus the combination fails to render any of the claims obvious.

Claims 1, 2, 4, 8, 10, 12-14, and 18-22 are directed to a method that includes "setting the angle between the grinding wheel rotational axis and roll rotational axis less than about 25 degrees." Each of these claims also requires "maintaining a ratio of axial taper tolerance (TT) to radial wheel wear compensation (WWC) of greater than 10" and "grinding the roll surface to a surface roughness R_a of less than 5 micrometer while leaving the roll surface substantially free of feed marks, chatter marks, and surface irregularities." The Office Action fails to state where in *Isamu* and *White* these limitations are taught, and the references in fact contain no such teaching.

To find a claim obvious, the Patent Office must make "a searching comparison of the claimed invention – including all its limitations – with the teachings of the prior art." *In re Ochai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added); see also *In re Wada and Murphy*, Appeal No. 2007.3733 (BPAI Jan. 18, 2008) (obviousness rejection reversed when the Examiner did not explain where or why the cited references disclosed a particular claim limitation). Here, the Office Action does not explain where any of the references teach the limitations above, and the reference contain no such teachings. Applicants respectfully request withdrawal of the rejections of claims 1, 2, 4, 8, 10, 12-14, and 18-22.

Claims 31 and 36 are directed to a method that includes grinding "wherein a ratio of TT to WWC is greater than 25." The Office Action fails to state where in *Isamu* and *White* these limitations are taught as required by MPEP § 2143 and *In re Ochai*, and the references in

fact contain no such teaching. Applicants respectfully request withdrawal of the rejections of claims 31 and 36.

3. Claim 5

The Office Action contains no comment on claim 5. Applicants request allowance of claim 5.

CONCLUSION

Based on the arguments presented above, Applicants request withdrawal of the rejections and allowance of all claims. If the Examiner has any questions or comments or needs any additional information, I invite the Examiner to telephone me at the number listed below.

Respectfully submitted,

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Date: September 17, 2008